

Application No.: 09/740,930

Docket No.: 21736-00011-US

REMARKS

This is in response to the Final Rejection of October 21, 2004. An accompanying request for a three-month extension of time makes this response timely.

Applicant is herewith filing a Request for Continued Examination. This submission includes new claims 51-102, including independent method claims 51, 63, 99 and 101 and corresponding independent apparatus claim 75, 87, 100 and 102.

Applicant submits that the claims patentably define over the prior art relied on in the Final Rejection.

Claim 51 is directed at a method for conducting a computer-implemented auction of a first set of items. The computer-implemented auction is conducted "in association with a related auction of a second set of items." In addition to the steps of "initiating the computer-implemented auction by identifying the first set of items," and "inputting bids from bidders for items in the first set of items" and then "determining whether the computer-implemented auction should terminate," and in that event, "assigning the first set of items to bidders based on the bids in force at the time the computer-implemented auction was terminated," claim 51 also calls for "constraining the inputted bids based on bids for the second set of items in the related auction." Claim 99 includes similar recitations.

Method claim 63 bears some resemblance to method claim 51 by calling for conducting a computer-implemented auction of a first set of items where the auction is conducted in association with a related auction of a second set of items. Claim 63 specifies that "at least one item in the first set having a complimentary item in the second set." Claim 63 specifies that the method of conducting the auction includes "initiating the computer-implemented auction by identifying the first set of items," and then "inputting bids from bidders for items in the first set of items, at least one of the bids from one of the bidders conditional on said bidder winning a complimentary item in the related auction." Thereafter, "determining whether the computer-implemented auction should terminate." In the event that the auction terminates, "assigning the

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first set of items to bidders based on the bids in force at the time the computer-implemented auction was terminated, excluding any conditional bids that do not satisfy their conditions.”

Method claim 101 includes similar recitations.

Thus, while claims 51, 63, 99 and 101 are related to a computer-implemented auction, in each case the results of the auction depend on either events in, or the outcome of, the related auction. For example, in claim 51 the auction of the first set of items is impacted by the related auction because the bids input in the computer-implemented auction are constrained “based on bids for the second set of items in the related auction.” Likewise, as recited in method claim 63, the computer-implemented auction of the first set of items includes at least one bid which is “conditional on said bidder winning a complimentary item in the related auction.” The outcome of the computer-implemented auction of the first set of items is impacted, because the first set of items are only assigned to bids “excluding any conditional bids that do not satisfy their conditions.” Similar recitations are found in the apparatus claims 75, 87, 100 and 102.

Applicant has argued in the past that the rejected claims patentably distinguish from the art based on the “decision means” recitation. Applicant had argued that none of the cited references taught such a decision means. The Final Rejection alleges that “Fujisaki further discloses a decision means responsive to the bid information received from the user system for determining whether an auction should continue or terminate.” (pp 4-5 of the Final Rejection), relying on 7:24-27; 51-53; 10:32-59; 13:21-27. The Final Rejection also notes that Applicant had argued that Fujisaki does not teach any decision means and indicated that the Examiner disagreed. Detracting from the creditability of the assertion regarding the teaching of Fujisaki is the further statement to the effect that “whether or not such a teaching is noted in Fujisaki, the Examiner notes that most auctions will eventually stop or terminate based on the occurrence of a certain event” (p. 2 of the Final Rejection).

Applicant is willing to concede that most auctions do terminate. Applicant submits, however, that that fact has absolutely nothing to do with the patentability of the rejected claims or the pending claims. Applicant is claiming a method or apparatus for a computer-implemented auction which includes a particular step or element, e.g., in the rejected claims the “decision

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means,” in the pending claim, the step of “determining whether the computer-implemented auction should terminate or the “means for determining whether the computer-implemented auction should terminate.” The Examiner has cited auction-related teachings which include computers. Applicant has argued and is presently arguing that those computer-based systems do not include the “means for determining” and the references do not teach the step of “determining whether the computer-implemented auction should terminate.” The fact that other auctions (auctions which are not computer-implemented) do terminate, in Applicant’s view, plays no part in the determination of the patentability of the pending claims.

Moreover, method claims 51 and 99 have a step of “constraining the inputted bids, based on bids for the second set of items in the related auction.” Claims 75 and 100 recite similar subject matter, e.g., means for constraining the inputted bids, based on bids for the second set of items in a related auction.” Applicant submits there is absolutely nothing in any of the cited references which is in any way related to this subject matter and Applicant submits that claims 51, 99, 75 and 100, and the claims dependent thereon, are patentable for this particular reason.

Claims 63 and 101 include in step (b) that at least one of the bids which is input is “conditional on said bidder winning a complimentary item in the related auction.” The assigning step in claim 63 and 101 specifies that the items are assigned “based on the bids in force at the time the computer-implemented auction was terminated, excluding any conditional bids that do not satisfy their conditions.” Claims 87 and 102 recite similar subject matter in the “means for inputting bids” where “at least of the bids from one of the bidders is conditional on said bidder winning a complimentary item in the related auction.” The claims conclude by specifying the “means for assigning” which operates “excluding any conditional bids that do not satisfy their conditions.” Applicant submits that none of the cited art has any teaching which is remotely related to the subject matter of claims 63, 87, 101 and 102. Applicant submits that these claims and the claims dependent thereon are patentable for this particular reason as well.

The Final Rejection also refers to Fisher and Walker patents, as well as the Fritts publication. The Office Action admits that the Fisher patent, although directed at an auction system does not “explicitly” describe a computer determining whether the auction should

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continue. The Walker patent and the Fritts publication are not relied on for this subject matter either. Walker is relied on allegedly for describing a "system" which has a function of "awarding or assigning a complimentary second object to a successful purchaser of a first object and based on purchase conditions of the first object." Actually, what Walker describes is the offering of a complimentary object to an individual who has purchased (not at an auction) a first object. Fritts describes "complimentary licenses." However, there is nothing to "connect" the disparate teachings of Walker's retail sales procedures and the existence of complimentary licenses as revealed by Fritts with either of the auction systems disclosed by Fisher and/or Fujisaki. Even if there were some basis for "connecting" these disparate disclosures, there is certainly no teaching that an auction be dependent on the outcome of a different auction such as either by constraining bids in one auction based on bids in another auction, or making bids in one auction conditional on the outcome of another auction.

Applicant submits that claims 51-102 are clearly patentable and an early allowance is solicited.

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Respectfully submitted,

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